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REMARKS

The final Office Action dated January 29, 2004 and the subsequent Advisory Action have been reviewed and carefully considered. Claims 1-4 remain pending, of which the independent claims are 1 and 2. Claims 1-3 have been amended. Reconsideration of the above-identified application, as amended and in view of the following remarks, is respectfully requested.

Claims 1-3 stand objected to for the informality of referring to as an “error packet” “a packet in which an error is detected.” The latter expression is suggested in the final Office Action, examination having been based on this latter expression. Substitution of the latter expression has now been made in claims 1-3 as suggested. No other amendment is being made.

Claim 1 stands rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 5,999,538 to Haddock et al. (“Haddock”).

Claim 1 recites:

receiving a packet from the physical layer and transmitting the packet to a switch;
detecting for an error while transmitting the packet;
upon detection of the error, stopping the transmission of the packet in which the error is detected to the switch without waiting for a complete reception of the entire packet in which the error is detected; and
transmitting a signal indicating an occurrence of the error and a signal indicating an end of the packet to the switch.

Haddock fails to disclose or suggest “transmitting the packet to a switch.” The only switch disclosed or suggested in Haddock is a node that happens to be a switching hub (col. 6, line 29: “switching hub”). Such an interpretation leads to problems

in interpreting the rest of the claim language in a way that would leave it anticipated. If a switch such as that disclosed in the specification on page 2, line 18 was intended, this also leads to problems in claim interpretation in trying to find claim 1 anticipated. Moreover, a switch in the latter sense is not disclosed nor suggested in Haddock. It is perhaps being suggested that such a switch is inherent in Haddock, but such a suggestion would not be valid.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) MPEP 2131.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) MPEP 2112.

Since the Haddock disclosure does not necessarily feature such a switch, Haddock does not disclose such a switch for purposes of anticipation.

In addition, item 5 of the final Office Action seemingly suggests that Haddock discloses receiving a packet, transmitting it to the switch, detecting an error while transmitting the packet to another Haddock node (col. 2, lines 18: "nodes"), and stopping the transmission to the switch upon detecting an error. At the very least, however, Haddock

makes no disclosure or suggestion of “stopping the transmission of the packet in which the error is detected to the switch.” Instead, Haddock stops transmission to the medium (col. 2, lines 23-24: “stops transmitting their data packet . . .”; line 35(36): “transmitting the data packet on to the medium”). Any attempt to suggest that transmission is “inherently” stopped to “the switch” suffers from the same deficiency. To say it is inherent means that it necessarily is so, whereas nothing in Haddock implies necessarily “stopping the transmission of the packet in which the error is detected to the switch.”

Haddock fails, additionally, to disclose or suggest “detecting for an error while transmitting the packet; upon detection of the error, stopping the transmission of the packet . . . transmitting a signal indicating an occurrence of the error and a signal indicating an end of the packet to the switch” as explicitly expressed in the language of claim 1.

For at least all of the above reasons, Haddock fails to anticipate the invention as recited in claim 1. Nor would claim 1 be obvious in view of Haddock.

Claims 2 and 3 stand rejected under 35 U.S.C. 103(a) as unpatentable over applicant’s allegedly admitted prior art (AAPA) in view of U.S. Patent No. 5,493,562 to Lo.

Claim 2 recites:

receiving a packet from the physical layer, storing the received packet in the memory, and transmitting the received packet to the switch;
 detecting for error while receiving the packet;
 upon detection of the error, stopping the storage of the packet in which the error is detected in the memory and the transmission of the packet in which the error is detected to the switch without waiting for a complete reception of the packet in which the error is detected . . .

Item 7 of the final Office Action appears to tout lines 15-22 of page 2 of the

applicant's specification for disclosure of the receiving, detecting and stopping steps of claim 2 of the present invention. The applicant traverses this proposition.

The only stopping mentioned in that passage applies to a packet not exceeding 64 bytes in length, but there is no disclosure or suggestion of "transmitting the received packet to the switch" which is explicitly required by the language of claim 2. Instead, the passage mentions that, as to the short packet, "the MAC layer will discard the error packet" (applicant's specification, page 2, lines 16). It would be, again, improper to suggest "inherency," since it is far from necessarily established by AAPA that the erroneous packet, or any part of it, ever arrives at the switch.

Lo is directed to use of a repeater, as "a convenient place to gather error statistics for network management" (Lo, col. 1, lines 35-38), for parsing relevant information from an erroneous packet for storage so that another processor can subsequently examine the information and related statistics.

The final Office Action seemingly suggests that the existing IEEE 802 (applicant's specification, page 2, lines 12-13: "IEEE (Institute of Electrical and Electronics Engineers) 802") standard be modified so that a node, if it is a repeater, will withdraw any error statistic gathering function from the upper layer and assume that function in the MAC layer instead. It is unclear what happens, in the proposed combination, if the node is in fact not a repeater, or how IEEE 802 is to be implemented for networks without a repeater. For these reasons alone, the combination appears awkward.

According to the present invention, performance proceeds by "upon detection of the error, stopping the storage of the packet in which the error is detected in the

memory.” Lo, by contrast, will not stop storing information from the erroneous packet at least until the desired information is extracted (col. 4, lines 55-56). For this reason too, the proposed combination of references fails to render obvious the invention as recited in claim 2.

For at least the foregoing reasons, the proposed combination of alleged prior art fails to render obvious the invention as recited in claim 2.

Claim 4 stands rejected under 35 U.S.C. 103(a) as unpatentable over AAPA in view of Lo and U.S. Patent No. 6,295,281 to Itkowsky et al. (“Itkowsky”).

Claim 4 depends from claim 2. The Itkowsky reference discloses the use of FIFOs in an Ethernet repeater, but cannot make up for the deficiencies in the references applied in rejecting claim 2 of the present invention. Accordingly, the proposed combination of references fails to render obvious the invention as recited in claim 2.

Of the remaining claims, each depends from a base claim and is patentable at least due its dependency. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of the patentability of each on its own merits is respectfully requested.

For all of the foregoing reasons, it is respectfully submitted that the present application is in condition for allowance, and a notice to that effect is respectfully solicited.

If any issues remain which may best be resolved through a telephone communication, the Examiner is requested to kindly telephone the undersigned telephone number listed below.

Enclosed is a check for \$420 in payment of the fee for a two-month extension in the time to reply to the final Office Action. If there are any additional fees due and owing, please charge Deposit Account No. 502-470.

Respectfully submitted,

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